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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,421	04/08/2009	Yehuda Yavets-Chen	P-5767-US	4105
49443	7590	05/19/2011	EXAMINER	
Pearl Cohen Zedek Latzer, LLP			TRAN, THIEN S	
1500 Broadway			ART UNIT	
12th Floor			PAPER NUMBER	
New York, NY 10036			3742	
			NOTIFICATION DATE	DELIVERY MODE
			05/19/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@pczlaw.com
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Office Action Summary	Application No. 10/568,421	Applicant(s) YAVETS-CHEN ET AL.	
	Examiner THIEN TRAN	Art Unit 3742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/14/2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 March 2011 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/29/2011</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation of claim 21 that recites “the compression device is electrically, pneumatically or hydraulically operable” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
2. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 19, 20 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida (US 6,352,020) in view of Young (US 2003/0097938) and Ikeda (US 5,009,905).

6. Regarding claim 19, Uchida teaches a sushi maker (Col 3, Lines 11-17) comprising: a base plate (Figs 2-4, Item 2, Col 5, Lines 6-10); a roll-up sheet (Figs 2-4, Item 3, Col 5, Lines 6-10) for holding a seaweed layer, the roll-up sheet (Figs 2-4, Item 3) being positionable on the base plate (Figs 2-4, Item 2); a cooked-rice container with an opening (Fig 1, Items 12 & 13, Col 5, Lines 1-5) for dispensing a layer of rice on the seaweed layer when held by the roll-up sheet, and a cutting device (Fig 1, Col 2, Lines 25-31, cutter device not shown) for separating the dispensed layer of rice from rice contained in the container. Uchida discloses the claimed except for the roll-up sheet is

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in substantially flat configuration when held by clamps, rollable into a cylindrical configuration when released from the clamps; and the area of the opening being substantially equal to the area of the seaweed layer.

7. In analogous art of sushi mold apparatus, Young discloses the roll-up sheet (Figs 14 & 15, Item 156, Pg 4, 0045) is in substantially flat configuration when held by clamps (Figs 14 & 15, Items 165-167 & 161, 172, 174 & 176, Pg 4, 0045), rollable into a cylindrical configuration when released from the clamps (Figs 9-10, Item 56, Pg 3, 0036) for the purpose of forming a sushi roller apparatus to form traditional sushi pieces (Pg 4, 0045). It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of Uchida with the roll sheet structure of Young for the purpose of forming a sushi roller apparatus to form traditional sushi pieces.

8. In analogous art of sushi forming method, Ikeda discloses the area of the opening (Figs 5 & 6, Item 11, Col 4, Lines 9-16) being substantially equal to the area of the seaweed layer (Figs 5 & 6, Item 20, Col 4, Lines 9-16) for the purpose receiving and securing predetermined quantities of layered food to form sushi (Col 1, Lines 45-50). It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of Uchida and Young with the opening size of Ikeda for the purpose of receiving and securing predetermined quantities of layered food to form sushi.

9. The examiner considers the limitations "for holding a seaweed layer, the roll-up sheet is in substantially flat configuration when held by clamps, rollable into a cylindrical configuration when released from the clamps; and for separating the dispensed layer of

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rice from rice contained in the container” as function or intended-use language.

Because the claims are directed to a sushi making apparatus and Uchida, Young and Ikeda discloses the structural limitations of the claim, it meets all the claim limitations.

10. While intended use recitations and other types of functional language cannot be entirely disregarded. However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); In re Otto, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963).

11. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). See also MPEP § 2114.

12. The manner of operating the device does not differentiate an apparatus claim from the prior art. A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

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13. Regarding claim 20, Uchida teaches comprising a compression device (Fig 1, Items 132 & 133, Col 1, Lines 33-37) for extruding rice (Fig 1, Item R, Col 1, Lines 33-37) from the container (Fig 1, Items 12 & 13, Col 5, Lines 1-5) through the opening.

14. Regarding claim 27, Uchida discloses the claimed invention except for comprising a mechanism attached to the base plate and engaging the clamps, the mechanism operable to controllably roll the roll- up sheet from its substantially flat configuration to its cylindrical configuration. In analogous art of sushi mold apparatus, Young discloses comprising a mechanism (Figs 14 & 15, Items 158 & 160, Pg 4, 0045) attached to the base plate (Figs 14 & 15, Item 164, Pg 4, 0045) and engaging the clamps (Figs 14 & 15, Items 165-167 & 158, 161, 172, 174 & 176, Pg 4, 0045), the mechanism operable to controllably roll the roll-up sheet (Figs 14 & 15, Item 156, Pg 4, 0045) from its substantially flat configuration to its cylindrical configuration (Figs 8-11, Pg 4, 0037) for the purpose of forming traditional sushi pieces (Pg 4, 0045). It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of Uchida with the roll sheet structure of Young for the purpose of forming traditional sushi pieces.

15. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida (US 6,352,020), Young (US 2003/0097938) and Ikeda (US 5,009,905) as applied to claim 19, in view of Tateno (US 5,381,728).

16. Regarding claim 21, Uchida teaches the compression device (Fig 1, Items 132 & 133, Col 1, Lines 33-37) is manually operable, electrically operable, pneumatically operable, or hydraulically operable. The examiner interprets that the compression

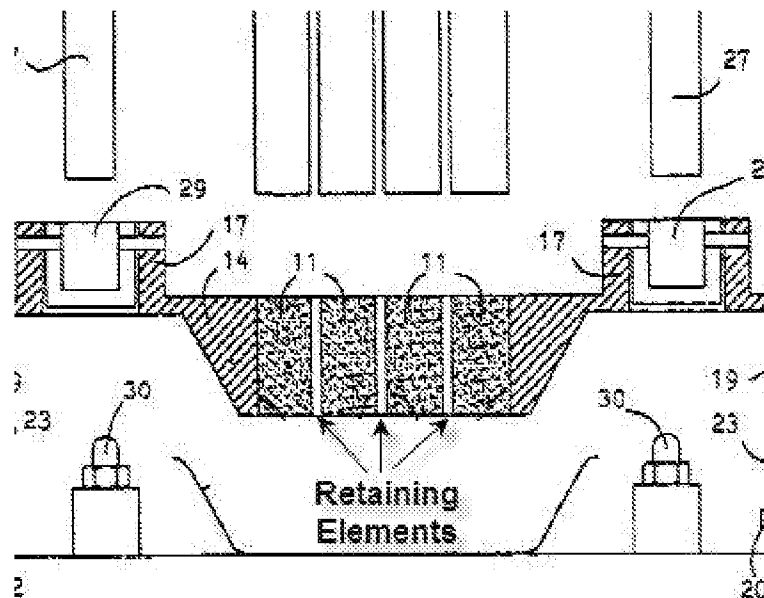
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device of Uchida is driven by a power source that is implicitly is manually, electrically, pneumatically, or hydraulically operable. In analogous art of apparatus for the preparation of sushi products, Tateno discloses the compression device (Figs 1 & 2, Items 16, 54 & 72, Col 6, Lines 65-68) is manually operable, electrically operable (Fig 1, Item 100, Col 6, Lines 65-68, electric motor), pneumatically operable, or hydraulically operable for the purpose of driving the rotation of the drums (Col 6, Lines 65-68). It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of Uchida, Young and Ikeda with the electric motor of Uchida for the purpose of driving the rotation of the drums.

17. Claims 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida (US 6,352,020), Young (US 2003/0097938) and Ikeda (US 5,009,905) as applied to claim 19, in view of Wade (US 6,217,311).

18. Regarding claim 22, Uchida, Young and Ikeda discloses the claimed invention except for comprising a plurality of retaining elements across the opening for retaining the rice inside the container when no pressure is applied on the rice. In analogous art of apparatus for and method of portioning rice, Wade discloses comprising a plurality of retaining elements (Fig 2, retaining elements, see below) across the opening for retaining the rice (Fig 2, Item 11, Col 3, Lines 23-25) inside the container (Fig 2, Item 14, Col 2, Lines 45-50) when no pressure is applied on the rice for the purpose of portioning rice for making sushi (Col 1, Lines 4-6). It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of

Uchida, Young and Ikeda with the retaining elements of Wade for the purpose of portioning rice for making sushi.



19. Regarding claim 23, Uchida, Young and Ikeda discloses the claimed invention except for the plurality of retaining elements are substantially evenly spaced, and the cutting device comprises a plurality of substantially evenly spaced cutting elements for moving a predetermined distance across the layer of rice from a position substantially aligned with the retaining elements. In analogous art of apparatus for and method of portioning rice, Wade discloses comprising the plurality of retaining elements (Fig 2, retaining elements, see above) are substantially evenly spaced, and the cutting device comprises a plurality of substantially evenly spaced cutting elements (Fig 2, Items 26, Col ,3 Lines 5-13) for moving a predetermined distance across the layer of rice (Fig 2, Item 11) from a position substantially aligned with the retaining elements (Fig 2, retaining elements, see above) for the purpose of separating the rice portions from the cavities and depositing the rice portions into the collecting trays (Col 3, Lines 56-60). It

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would have been obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of Uchida, Young and Ikeda with the retaining and cutting elements of Wade for the purpose of separating the rice portions from the cavities and depositing the rice portions into the collecting trays.

20. Regarding claim 24, Uchida, Young and Ikeda discloses the claimed invention except for the cutting device comprises a plurality of substantially evenly spaced cutting elements for moving a predetermined distance across the layer of rice. In analogous art of apparatus for and method of portioning rice, Wade discloses the cutting device comprises a plurality of substantially evenly spaced cutting elements (Fig 2, Items 26, Col ,3 Lines 5-13) for moving a predetermined distance across the layer of rice (Fig 2, Item 11) for the purpose of separating the rice portions from the cavities and depositing the rice portions into the collecting trays (Col 3, Lines 56-60). It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of Uchida, Young and Ikeda with the cutting elements of Wade for the purpose of separating the rice portions from the cavities and depositing the rice portions into the collecting trays.

21. Regarding claim 25, Uchida, Young and Ikeda discloses the claimed invention except for the predetermined distance is substantially equal to the space between two adjacent cutting elements. In analogous art of apparatus for and method of portioning rice, Wade discloses the predetermined distance is substantially equal to the space between two adjacent cutting elements (Fig 2, Items 26, Col ,3 Lines 5-13). The examiner interprets that because the cutters of Wade (Fig 2, Items 26) can move any

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distance within the limits of the latch pins (Fig 2, Item 27) it meets the limitations of the claim because the cutters are capable of moving a predetermined distance that is substantially equal to the space between two adjacent cutting elements.

22. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida (US 6,352,020), Young (US 2003/0097938) and Ikeda (US 5,009,905) as applied to claim 19, in view of Setecka (US 3,465,894).

23. Regarding claim 26, Uchida, Young and Ikeda discloses the claimed invention except for comprising rails along which the container may be moved. In analogous art of portable food service device for tables and the like, Setecka discloses comprising rails (Figs 1 & 4, Items 10, 11, 12 & 13, Col 2, Lines 15-24) along which the container (Figs 1 & 4, Items 20, 35 & 38, Col 2, Lines 40-42 & Col 3, Lines 9-19) may be moved for the purpose of selectively moving any of the carriages and trays to any desired positions between the opposite ends of the table to permit quick serving of the foods supported thereon (Col 1, Lines 21-28). It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of Uchida, Young and Ikeda with the rails of Setecka for the purpose of selectively moving any of the carriages and trays to any desired positions between the opposite ends of the table to permit quick serving of the foods supported thereon.

24. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida (US 6,352,020), Young (US 2003/0097938) and Ikeda (US 5,009,905) as applied to claims 19 & 27, in view of Anderson (US 5,224,692).

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25. Regarding claim 28, Uchida teaches a mechanism (Figs 5a-c & 6a-c, Items 64 & 651, Col 6, Lines 60-65) for folding the rolling sheet (Figs 5a-c & 6a-c, Items 31-34, Col 6, Lines 50-55). Uchida, Young and Ikeda discloses the claimed invention except for the mechanism is in the form of a left-hand right-hand rotatable screw, the screw engaging nuts attached to the clamps. In analogous art of versatile wide opening vise, Anderson discloses the mechanism is in the form of a left-hand right-hand screw (Figs 1 & 2, Items 50 & 51, Col 2, Lines 59-64), the screw engaging nuts (Figs 1 & 2, Items 20 & 21, Col 3, Lines 1-6) attached to said clamps (Figs 1 & 2, Items 24 & 25, Col 3, Lines 9-13) for the benefit of providing movement to a pair of jaws along a base to desired clamping positions (Col 2, Lines 8-13). It would have been obvious to one having ordinary skill in the art to combine the teachings of Uchida, Young and Ikeda with the screw mechanism of Anderson for the benefit of providing movement to a pair of jaws along a base to desired clamping positions.

26. Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida (US 6,352,020), Young (US 2003/0097938) and Ikeda (US 5,009,905) as applied to claim 19, in view of Locker (US 2,240,221).

27. Regarding claims 29 and 30, Uchida, Young and Ikeda discloses the claimed invention except for the cutting device comprises a wire, the wire comprises stainless steel. In analogous art of egg and like slicing appliance, Locker discloses the cutting device (Figs 1-3, slicer, Col 2, Lines 10-15) comprises a wire (Figs 1 & 2, Item g, Col 2, Lines 25-30), the wire comprises stainless steel (Figs 1 & 2, Item g, Col 2, Lines 25-30) for the purpose of forming a food slicer (Col 2, Lines 10-15). It would have been

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obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of Uchida, Young and Ikeda with the wire of Locker for the purpose of forming a food slicer.

28. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida (US 6,352,020), Young (US 2003/0097938) and Ikeda (US 5,009,905) as applied to claim 19, in view of Southworth (US 4,425,706).

29. Regarding claim 31, Uchida, Young and Ikeda discloses the claimed invention except for the container is adapted to be moved with respect to the cutting device to slice off the rice layer. In analogous art of cutting tool, Southworth discloses the container (Figs 3 & 5, Item 30, Col 2, Lines 66-68) is adapted to be moved with respect to the cutting device (Figs 3 & 5, Items 10, 14 & 18, Col 2, Lines 37-47) to slice off the food layer (Figs 3 & 5, Item 31, Col 2, Lines 66-68) for the purpose of cutting the food item in any desired horizontal or vertical sections (Col 2, Lines 23-25). It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of Uchida, Young and Ikeda with the cutting device and container of Southworth for the purpose of cutting the food item in any desired horizontal or vertical sections.

Response to Amendment

30. Claims 1-18 are cancelled.

31. Claims 19-31 are new.

32. Claims 19-31 are pending.

Response to Arguments

33. Applicant's arguments filed on 3/14/2011 with respect to claims 19-31 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

34. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

35. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

36. Any inquiry concerning this communication or earlier communications from the examiner should be directed to THIEN TRAN whose telephone number is (571)270-7745. The examiner can normally be reached on Mon-Thurs, 8-5PM EST.

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37. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tu Hoang can be reached on 571-272-4780. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

38. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/THIEN TRAN/
Examiner, Art Unit 3742
5/9/2011

/Henry Yuen/
Supervisory Patent Examiner, TC
3700